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OFFICE OF PETITIONS

In re Application of :
Moutsatsos et al. :
Application No. 09/148,234 : DECISION ON PETITION
Filed: September 4, 1998 : PURSUANT TO
Attorney Docket No.: P-4739- : 37 C.F.R. § 1.137(B)
US :
Title: GENETICALLY :
ENGINEERED CELLS WHICH :
EXPRESS BONE MORPHOGENETIC :
PROTEINS :
:

This is a decision on the petition pursuant to 37 C.F.R. § 1.137(b), filed January 26, 2011, to revive the above-identified application.

This petition pursuant to 37 C.F.R. § 1.137(b) is **DISMISSED**.

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R. § 1.113 in a timely manner to the final Office action mailed July 20, 2010, which set a shortened statutory period for reply of three months. No response was received, no extensions of time under the provisions of 37 C.F.R. § 1.136(a) were obtained, and no further responses were received. Accordingly, the above-identified application became abandoned on October 21, 2010. A notice of abandonment was mailed on March 3, 2011, subsequent to the filing of this petition.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in 37 C.F.R. § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
- (4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. § 1.20(d)) required pursuant to paragraph (d) of this section.

With this petition, Applicant has submitted the petition fee and the proper statement of unintentional delay.

Petitioner has also submitted a three-month extension of time. An extension of time under 37 C.F.R. § 1.136 must be filed prior to the expiration of the maximum extendable period for reply.¹ Accordingly, since the \$ 1,110 extension of time submitted with the petition on January 26, 2011 was filed subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to Deposit Account No. 50-3355 in due course.

The second and third requirements of Rule 1.137(b) have been satisfied. The fourth requirement of Rule 1.137(b) is not applicable, as a terminal disclaimer is not required.²

The present petition is not grantable because the first requirement of Rule 1.137(b) has not been satisfied. Petitioner did not submit the required reply to the Office action. The required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed.³ In order for the application to be revived, Petitioner must submit a reply which satisfies 37 C.F.R. § 1.137(b)(1) (i.e., a Notice of Appeal (and fee required by law); an amendment that *prima facie* places the application in condition for allowance; a continuing application under 37 C.F.R. § 1.53(b); a request for continuing examination under 37 C.F.R. § 1.114, if applicable; or a 37 C.F.R. § 1.129(a) submission, if applicable). None of these items appears to have been submitted with this petition.

¹ See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988).

² See Rule 1.137(d).

³ See M.P.E.P. § 711.03(c).

If reconsideration of this petition is desired, Petitioner may file a reply including a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.137(b)." This is not a final agency action within the meaning of 5 U.S.C § 704.

If reconsideration of this decision is desired, any response to this decision must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.137(b)." This is not a final agency action within the meaning of 5 U.S.C § 704.

Any future submission concerning this matter should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail,⁴ hand-delivery,⁵ or facsimile.⁶ Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.⁷

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.⁸ All other inquiries concerning examination procedures should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

⁴ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

⁵ Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

⁶ (571) 273-8300: please note this is a central facsimile number.

⁷ <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

⁸ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).